

REMARKS/ARGUMENTS

Applicants have reviewed the Action and thank the Examiner for the analysis reflected therein. Applicants traverse the rejections for the following reasons, and request favorable reconsideration of the pending claims.

Claims 12-22 are pending, with claims 12 and 18 being independent claims. By way of summary, claims 12-17 were rejected under 35 U.S.C. 103(a) over Billet (EP 1044915) in view of Hanlan (US 4,361,260), while claims 18-22 were rejected under 35 U.S.C. 102(b) as being anticipated by Billet.

Applicants respectfully submit that the cited art does not anticipate or make obvious any pending claim. Turning first to claim 18, this claim contains numerous important limitations that are nowhere addressed in the Action. For ease of reference, claim 18 is reproduced below:

18. An apparatus for controlling a cut register of a web-fed rotary press having a web guided from a last printing unit to a cross cutting device via a plurality of pulling units, wherein the pulling units are independently rotatable from one another and from the cross-cutting device, there being no movable tensioning roller between the pulling units, and the cut register representing placement of cuts on the web, the apparatus comprising:

a controller connected to a motor of at least one of the pulling units; and

a first cut-register sensor disposed to detect a first actual value of the cut register on the web and feed the detected first actual value to the controller, wherein the controller controls the motor to adjust a speed of said at least one pulling unit based on the first actual value of the cut register.

As can be seen, the claim requires a plurality of pulling units configured in a certain manner. While the Action alleges that limitations in the preamble can be ignored, this is not a correct statement of law. Limitations in the preamble can be disregarded *ONLY* WHEN the remaining structural limitations can stand alone, i.e., without the preamble. This is quite clearly not the case here. Consider the claim *without* the preamble:

18. (without preamble) An apparatus comprising:

a controller connected to a motor of at least one of the pulling units

[What pulling units?

How many?

What are they pulling?

Where are they?]; and

a first cut-register sensor disposed to detect a first actual value of the cut register

[What cut register?

What does it even represent?]

on the web and feed the detected first actual value to the controller, wherein the controller controls the motor to adjust a speed of said at least one pulling unit based on the first actual value of the cut register.

Clearly, the remaining claim limitations could **not** stand on their own – in fact, the preamble provides the necessary antecedent basis for multiple elements within each of the remaining claim limitations.

This is not a close case that requires a judgment call – this is an extreme case, and it is one that the Federal Courts have already decided in Applicants’ favor. Please see *Bicon Inc. v. Straumann Co.*, 78 USPQ2d 1267 (Federal Circuit 2006) (preamble **is limiting** if limitations in body of claim rely upon and **derive antecedent basis** from preamble); *see also Eaton Corp. v. Rockwell International Corp.*, 66 USPQ2d 1271 (Federal Circuit 2003) (“The ... steps ... require the manipulation of particular structures that are identified and described only by the preamble, ... We therefore conclude that the **preamble ... limits the claimed invention.**”)

Further, please note that the Federal Circuit did not leave any room to assume that such preambles might nonetheless be considered to state a purpose or intended use. Indeed, the Federal Circuit explicitly **criticized** and **rejected** that line of reasoning with respect to cases where the preamble is required for antecedent basis. *See Eaton* at p. 1277 (“Claim 14 [wherein preamble provides antecedent basis] is an example of the claim drafter choos[ing] to use both the preamble and the body to define the subject matter of the claimed invention...**as opposed to** a preamble reciting an intended use for an invention”) (internal citations omitted).

Thus, as a clear legal matter, the preamble of claim 18 **cannot** be ignored. Thus, numerous significant limitations of the claim have been improperly ignored. As such, a

prima facie case of unpatentability has not been presented with respect to claim 18, and allowance of claim 18 is requested.

With respect to independent claim 12, the Action admits that Billet fails to teach a system of pulling rollers without a movable tensioning roller between them. However, seeing that Hanlon lacks such a roller, the Action suggests that it would be obvious to simply remove the tensioning roller from Billet as well. Not only would such a move be nonobvious, it would be vandalism -- the resulting system would utterly fail to function. Indeed, the system of Billet quite clearly *relies on* the tensioning roller to function at all. As will be easily appreciated, Billet's system performs "stop cutting" (i.e., the web at the cutter is stopped momentarily during the cut). As noted in Billet, and as those of skill in the art know, such stop cutting is only possible with the use of a tensioning roller to take up slack when the web stops at the cutter but is still moving elsewhere. Thus, if Billet's tensioning roller were removed, not only would Billet's particular improvement no longer work, but the entire press would fail because the web would be torn apart as part of it stops and part of it keeps going.

Thus, it would not have been obvious or even possible to remove the tensioning roller from Billet's system, and thus favorable reconsideration of claim 12 is requested.

Because independent claims 12 and 18 are patentable as discussed above, it is submitted that the remaining dependent claims are also patentable for at least these reasons, and favorable reconsideration of all pending claims is requested.

Conclusion

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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Date: February 24, 2010